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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,234	03/12/2004	Trent A. Shidaker	WUR 50656/USw/2	7528

7590 09/29/2006

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EXAMINER

SERGEANT, RABON A

ART UNIT PAPER NUMBER

1711

DATE MAILED: 09/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/799,234

Applicant(s)

SHIDAKER ET AL.

Examiner

Rabon Sergeant

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/12/04</u> . | 6) <input type="checkbox"/> Other: ____ |

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1. It is requested that applicants amend the specification to reflect the current status of parent application, 09/954,311.
2. The disclosure is objected to because of the following informalities: Within line 20 of page 7, the disclosed formula is incomplete in that it lacks the required bonds. Appropriate correction is required.
3. Claims 1-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants have failed to define the language, "essentially free", as it pertains to the oxyalkylene units of the poly(dimethylsiloxane)-polyoxyethylene surfactant. It cannot be determined what amount of the oxyalkylene units in question may be present and still satisfy the language.
4. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Within claim 1, the language, "essentially free", as it pertains to the oxyalkylene units of the poly(dimethylsiloxane)-polyoxyethylene surfactant renders the claims indefinite, because it cannot be determined what amount of the oxyalkylene units in question may be present and still satisfy the language.

Within claims 2 and 3, the language, "about 24", "about 25", "about 100", and "about 30", renders the claims indefinite, because it is unclear with respect to exactly what species of

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compounds are encompassed by the claims. For example, it cannot be determined if compounds wherein x is 26 are within the scope of the claims.

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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6. Claims 1, 3-8, 15, and 16 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 9 of U.S. Patent No. 6,887,911.

Although the conflicting claims are not identical, they are not patentably distinct from each other because each claim set is drawn to a reaction system comprising components that read on each other.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dempsey et al. ('696) in view of Parks et al. ('176) or Mackey ('553 or '528) and further in view of Gillis et al. ('107 or '939).

Dempsey et al. disclose the production of molded polyurethane products, including SRIM products, wherein an internal mold release agent comprising fatty polyesters, that correspond to applicants' claimed fatty polyester, is utilized with a polysiloxane surfactant that corresponds to

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applicants' claimed poly(dimethylsiloxane)-polyoxyethylene surfactant. Dempsey et al. disclose this surfactant as L-6980. See examples. Dempsey et al. further teach at column 8, line 16 that surfactants corresponding to those of applicants are preferred components of the composition.

7. Dempsey et al. fail to disclose applicants' component c)ii), fatty acid; however, applicants' specifically claimed mold release agent comprising both a fatty polyester and a fatty acid were known to be useful internal mold release agents for RIM and SRIM polyurethane moldings at the time of invention. This position is supported by the teachings of Parks et al. and Mackey. Parks et al. disclose applicants' claimed internal mold release agent within the abstract; column 2; and column 3, lines 1-46. Mackey discloses applicants' claimed internal mold release agent within the abstract and columns 3 and 4. The references further disclose the use of surfactants. See column 7, lines 30-47 within Parks et al. See column 9, lines 18-20 within Mackey.

8. Since it has been held that it is prima facie obvious to utilize a known component for its known function and in view of the teachings within Parks et al. and Mackey to utilize a fatty acid component in admixture with a fatty polyester component to produce mold release compositions for SRIM polyurethane moldings, the position is taken that it would have been obvious to incorporate the claimed fatty acid into the mold release agent composition of Dempsey et al., so as to arrive at the instant invention. *In re Linder*, 173 USPQ 356. *In re Dial et al.*, 140 USPQ 244.

9. Furthermore, Gillis et al. disclose that the combination of polysiloxane surfactants with mold release agents comprising a fatty acid ester component yields a synergistic result in terms of the effectiveness of the mold release property in SRIM systems. See column 2, line 55.

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While Gillis et al. fail to specifically disclose applicants' claimed surfactant and mold release agent, the position is taken that, since each of the disclosed mold release agents within Dempsey et al., Parks et al., and Mackey is derived from long chain fatty compounds, the mold release agents of these references are analogous to the mold release agent of Gillis et al. to the extent that one of ordinary skill would have expected them to yield comparable release properties to that of Gillis et al. Accordingly, one would have reasonably expected that the combined use of fatty compound based release agents and polysiloxanes would yield SRIM compositions having improved mold release, relative to compositions not employing these respective components in combination.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

R. Sergent
September 27, 2006


RABON SERGENT
PRIMARY EXAMINER